

### REMARKS/ARGUMENTS

Claims 16 – 29 are presented for further examination in view of the foregoing amendments and following remarks. By this Response and Amendment, claims 1 – 15 are cancelled without prejudice or disclaimer. Claims 16 – 29 correspond to the previously presented claims 1 – 15, but have been amended in view of the rejections under 35 U.S.C. 112 and 35 U.S.C. 101 raised by the Examiner, and to more clearly recite the presently claimed inventive subject matter.

In the outstanding Office Action, the Examiner: rejected claims 1 – 15 under 35 U.S.C. 112, second paragraph, as being indefinite as failing to particularly point out and distinctly claim the subject matter which the application regards as the invention; rejected claims 9 – 11 under 35 U.S.C. 101 as improper process claims; and rejected claims 1 – 15 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,113,819 to Murakawa et al. (hereinafter referred to as “Murakawa”).

By this Response and Amendment, numerous amendments are made to the claims in view of the Examiner’s grounds for rejection under 35 U.S.C. 112 and 101. For ease of examination, claims 1 – 15 are cancelled, and these claims are presented as new claims 16 – 29. Nevertheless, Applicants submit that new claims 16 – 29 correspond in subject matter and structure to original claims 1 – 15, and that these amendments introduce no new matter to this application within the meaning of 35 U.S.C. 132. In particular, support for the amendments to the independent claims may be found not only in the original claims, but also in the original specification, and in particular on page 2, lines 8 – 16, which recite in part that the “partitioning layer is arranged in such a manner that it lies essentially horizontally, i.e. parallel to the vehicle flooring, and...over the engine block. In this way an essentially closed and acoustically effective cavity is formed between the closed engine hood and this partitioning layer...”

Accordingly, Applicants submit that the Examiner's rejections under 35 U.S.C. 112 and 101 have been obviated by the above amendments, and as amended, the Examiner's rejections of the pending claims under 35 U.S.C. 102(b) are traversed.

### **Rejections Under 35 U.S.C. §112, Second Paragraph**

The Examiner rejected claims 1 – 15 under 35 U.S.C. 112, second paragraph for being indefinite. Specifically, the Examiner:

- stated that the phrase “engine compartment partitioning layer” rendered claims 1 – 8 unclear because “it is unclear whether the claims recite many engine compartment partitioning layer or one”;
- stated that the previous claim language rendered unclear whether the applicant was claiming an engine compartment partitioning layer or a combination of the engine compartment partitioning layer and a vehicle engine compartment;
- stated that the phrase “Partitioning layer according to claim 2, wherein said partitioning layer” rendered claims 1, 2, 7, and 8 unclear;
- stated that it was unclear if the phrase “the engine compartment” in claim 9 referred to the same engine compartment as in claim 1;
- stated in regards to claims 9 – 11 that “[i]t is not clear the applicant intend to have the step of or comprising some thing;”
- stated that the phrase “using within an engine compartment a partitioning layer” rendered claims 9 and 10 unclear; and

- stated that the phrase “comprising forming” rendered claims 10 and 11 unclear.

### Response

As best understood, the above amendments are believed to obviate all of the Examiner’s rejections under 35 U.S.C. 112.

- The phrase “engine compartment partitioning layer” has been removed from the apparatus claims, which now positively recite an “engine compartment partition” which in turn comprises “one or more partition sections together shaped to horizontally divide the engine compartment above an engine...” (Claim 16) Thus, the claims recite one “partition,” which itself may comprise a single section *or* a plurality of sections. This claim language is believed to render moot the Examiner’s concerns regarding “whether the claims recite many engine compartment partitioning layer or one;”
- Claim 16 now clearly claims a “partition”, and not a combination of a partition and compartment. Although no compartment is claimed, Applicants have clarified that the partition, when placed in an engine compartment, forms an “acoustically effective cavity” “together with a closed hood of the engine compartment.” This claim language is believed to render moot the Examiner’s concerns regarding “whether the applicant was claiming an engine compartment partitioning layer or a combination of the engine compartment partitioning layer and a vehicle engine compartment.”

- Applicants have carefully reviewed claims 1, 2, 7, and 8, and cannot find the Examiner's cited language of "Partitioning layer according to claim 2, wherein said partitioning layer..." In fact, none of claims 1, 2, 7, or 8 made any reference whatsoever to claim 2. Nevertheless, Applicants submit that this phrase is not found in the presently presented claims.
- Applicants present new claims 16 and 27, which correspond to original claims 1 and 9, but which clarify that no engine compartment is positively recited in the claims. Rather, each claim refers to an engine compartment only as that thing for which the partition sections are "shaped" to divide (claim 16), or in which the partition sections are "placed" (claim 27);
- Applicants have reworded the method claims, which now positively recite that method comprises at least one step. This is believed to render moot the Examiner's concerns that "[i]t is not clear the applicant intend to have the step of or comprising some thing";
- Applicants have removed the term "using" from all method claims. This is believed to render moot the Examiner's concerns over this language.
- Applicants have removed the phrase "comprising forming" from all method claims, and have made it clear that any "forming" step is a substep of the claimed "placing" step. This is believed to render moot the Examiner's concern over this language.

### **Rejections Under 35 U.S.C. 101**

The Examiner rejected claims 9 – 11 under 35 U.S.C. 101. Specifically, the Examiner stated that these claims merely recited a “use,” without any steps involved in the process.

### **Response**

The above amendments are believed to obviate the Examiner’s rejections under 35 U.S.C. 101.

In particular, new method claims 27 – 29 do not recite the term “using,” as noted above. Rather, these claims recite active, positive steps such as “placing one or more partition sections above an engine,” “dividing the engine compartment,” and “forming at least one acoustically effective cavity.” Applicant submits that claims 27 – 29 constitute proper method claims under 35 U.S.C. 101.

### **Rejections Under 35 U.S.C. 102(b)**

The Examiner rejected claims 1 – 15 as being anticipated by Murakawa.

### **Response**

Initially, Applicants note with apprehension that the Examiner has twice rejected the present claims over Murakawa while repeatedly failing to identify all of the claimed features in the reference.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every

element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Impax Laboratories Aventis v. Pharmaceuticals*, 468 F.3d 1366, 1381 (Fed. Cir. 2006).

**Applicants draw the Examiner's attention to the following features from the original claims, which remain in the new claims. These features have never been identified by the Examiner as present in any piece of prior art.**

- a “compressed phenolic resinous nonwoven layer” comprised by a carrier layer (original claim 3; new claim 18);
- a “water and oil repellent layer” comprised by a carrier layer (original claim 4, new claim 19);
- a “slightly compressed phenolic resinous nonwoven layer” comprised by a sound absorbent layer (original claim 5, new claim 22);
- a “water and oil repellent layer” comprised by a sound absorbent layer (original claim 6, new claim 23);
- several “joinable and mutually complementary” sections of a partitioning layer (original claim 7, new claim 25);
- a “water and oil repellant...textile scrim or felt layer” on the engine hood side of a partition (original claims 4 and 12 , new claim 20);
- a “water and oil repellant...textile scrim or felt layer” on the ground side of a partition (original claim 6 and 14, new claim 24);
- an “acoustically effective aperture” (original claim 8, new claim 26);

Thus, Applicants traverse the Examiner's rejection under 35 U.S.C. 102(b), because these features have not been shown to have been disclosed, taught, or suggested by Murakawa. The Examiner *must* consider the patentability of each dependent claim, and not merely reject all claims on the basis of the independent claims alone.

**Further, the present independent claims (16, 27, and 28) are believed to recite features which are not found in the cited art of record.** In particular, the cited art does not disclose, teach, or suggest any of the following features:

- an “engine compartment partition” comprising “one or more partition sections together shaped to horizontally divide [an] engine compartment above an engine” (claim 16);
- “one or more partition sections [which] together with a closed hood of [an] engine compartment form an acoustically effective cavity” (claim 16);
- “horizontally dividing [an] engine compartment” (claims 27, 28); and
- “forming [one or more] acoustically effective cavit[ies] between...partition sections and a closed hood” (claims 27, 28).

Thus, Applicants again traverse the Examiner's rejection under 35 U.S.C. 102(b), because these features, which are more clearly recited in the new independent claims, are not disclosed, taught, or suggested by Murakawa.

Reconsideration of all rejections under 35 U.S.C. 102(b) are requested.

### CONCLUSION

In light of the foregoing, Applicant submits that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant respectfully requests that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

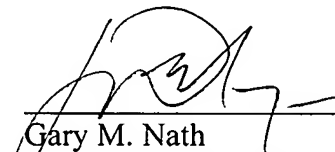
In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

**THE NATH LAW GROUP**

Date: December 17, 2007  
THE NATH LAW GROUP  
112 South West Street  
Alexandria, VA 22314  
(703) 548-6284

By:

  
\_\_\_\_\_  
Gary M. Nath  
Registration No. 26,965  
Jerald L. Meyer  
Registration No. 41,194  
Matthew Moffa  
Registration No. 58,860  
Customer No. 20529